

1 reference, or would be led in a direction divergent from the path that was taken by the
2 applicant.” *Optivus Technology, Inc. v. Ion Beam Applications S.A.* 469 F.3d 978, 989
3 (C.A.Fed. 2006) citing *In re Kahn* 441 F.3d 977 (C.A.Fed. 2006) (quoting *In re Gurley*,
4 27 F.3d 551, 553 (Fed.Cir.1994)).

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6 1. The Examiner, at page 3 states that claims 1-8 are rejected under 35 U.S.C. 103(a) as
7 being unpatentable over Hansen, No. 5,353,564 in view of Davis, No. 3,766,644 and
8 Graham, No 4,439,666.

9 The Examiner states that Hansen discloses a method and apparatus for using heat
10 (col. 4, lines 35-49) to reduce condensate in a building interior having a ceiling 64 with
11 an apex and a width from the ceiling apex to a wall 64; the interior wall surface having a
12 height from a building foundation to the ceiling and but not heating with an embedded
13 wire, temperature control, or moisture control.

14 The Examiner’s attention is drawn to Hansen at col. 4, lines 34-49 stating the
15 following:

16 **These objects are accomplished by** use of a construction technique which
17 provides for an interior wall and ceiling surface and an exterior wall and ceiling
18 surface with a between wall and ceiling air cavity. A forced air heating and/or
19 cooling system is provided for directing ducted air to the base of the between
20 wall cavity for supplying heated air to the between wall cavity during periods of
21 time when the outside atmosphere temperature falls below the desired inside
22 storage temperature in order to hold the interior surface temperature above the
23 dew point of the storage atmosphere. And, during periods of time when the
24 outside atmosphere temperature exceeds the interior storage temperature, for
25 injecting cool air into the between wall air cavity for purposes of holding the
26 interior wall surface temperature to an acceptably low temperature.

27 The structural presence, in Hansen, of cavities and ducts between an interior and
28 an exterior wall and ceiling, which received forced air, are structural features of primary
importance in Hansen. The Examiner is also directed to Hansen, Claim 1 reciting an “air
envelope...for circulating...air...” These features are not found in your applicant’s

EFS filing, Application No. 10/817,347
on October 29, 2007 by Floyd E. Ivey, 35552.

1 invention. Your applicant respectfully urges the Examiner to conclude that these
2 differences eliminates the Hansen structure from teaching a structure flowing toward the
3 structure of the present invention.
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5 The Examiner's attention is respectfully drawn to Davis. Davis is differentiated
6 from the present invention at Davis, col 2/lines 58-62 stating:

7 "With the present invention, **the radiant heat**, while being **directed into the interior of the room** is non-uniform and hence provides a more uniform heating comfort, since concentration of heat on the body is avoided. Essentially, the heating panel diffuses the radiant heat to provide more comfort.
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10 The Examiner's attention is directed to your present Specification and the fact that
11 the present structure is directed to the heating solely of the surface (4) as seen at
12 Specification, page 7/line 31 to page 8/line 1 stating:
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14 This allows the heat tape to maintain the temperature of the bottom board **such**
15 **that the interior surface is maintained at approximately 0.5 degrees over the**
16 **building interior temperature.**
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19 Your applicant respectfully urges the Examiner to conclude that Davis is
20 eliminated as a structure flowing toward the structure of the present invention. In light of
21 these distinctions in Hansen and Davis, your applicant respectfully urges the Examiner to
22 withdraw the rejection of claims 1-8 and 9-10.
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Additionally, claims are amended as follows:

25 Claim 1 is currently amended as follows: "b. at least one heating means (60),
26 composed of heat tape (60) or a fluid heat transfer system means (60), in thermal
27 contact with the interior surface of the bottom board (4).
28 EFS filing, Application No. 10/817,347
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1 communication with and affixed by..."

2 Claim 2 is currently amended as follows: "b. the at least one heating means (60)
3 heat tape (60) or a fluid heat transfer system means (60) affixed by heating means (60)..."

4 Claim 4 is currently amended as follows: "a. the at least one heating means (60)
5 composed of heat tape (60) or a fluid heat transfer system means (60);"

6 Claim 5 is currently amended as follows: "a. the at least one heating means (60)
7 composed of heat tape (60) or a ..."

8 Claim 6 is currently amended as follows: " b. heating the at least one insulating
9 board means (7) with a heating means (60), composed of heat tape (60) or a fluid heat
10 transfer system means (60), in thermal ..."

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22 **Law regarding 35 U.S.C. 103.**

23 The absence of a feature similar to the feature or features of the present invention
24 are respectfully argued as references which teach away from the disclosed and claimed
25 invention and thus are not appropriately a basis of rejection under 103. *KSR Intern. Co.*
26 v. *Teleflex Inc.* 127 S.Ct. 1727,1733 (U.S. 2007); *In re Gurley* 27 F.3d 551 at 553(1994)

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28 EFS filing, Application No. 10/817,347
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1 cafc). In general a reference will teach away if the line of development flowing from the
2 references disclosure is unlikely to be productive of the result sought by the applicant.
3 *KSR, Id.* 1733.

4 The Hansen duct structure for circulating air is a structure distinctly differing from
5 the present invention. The Davis structure comprises a heating element but differing in
6 structure from that seen in the present invention. Further, Davis is specifically taught as
7 heating the interior of a room. Your present invention heats solely the surface of the
8 board (4). Your applicant respectfully contends that both Hansen and Davis, separately
9 and in light of the other, are structures which teaches away from the structure of the
10 present invention. The art cited must be seen, separately and in combination, to teach
11 away from the invention disclosed and claimed by your applicant. The art cited does not
12 illustrate the structure of the present invention. There is no motivation to combine the
13 cited art to find taught or suggested the structure of the present invention.

14 The Examiner has urged prior art alone and in combination as rendering obvious
15 the present invention. However, there is not demonstrated teaching, suggestion or
16 motivation to so combine the several components in the manner done by your present
17 applicant. Such recitation of prior art does not form a basis for rejection as obvious. *C.R.*
18 *Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir.
19 1998), rehearing denied & suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed.
20 Cir. 1998) (''The ultimate question is whether, from the evidence of the prior art and the
21 knowledge generally available to one of ordinary skill in the relevant art, there was in the
22 prior art an appropriate teaching, suggestion, or motivation to combine components in the
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1 way that was done by the inventor."); *Chiuminatta Concrete Concepts, Inc. v. Cardinal*
2 *Industries, Inc.*, 145 F.3d 1303, 1312, 46 USPQ2d 1752, 1759 (Fed. Cir. 1998) ('for a
3 claim to be invalid for obviousness over a combination of references, there must have
4 been a motivation to combine the prior art references to produce the claimed invention.');

5 *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998), cert.
6 denied, 119 S. Ct. 177 (1998); *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437,
7 1447, 45 USPQ2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998) ('there
8 is no suggestion or teaching in the prior art to select from the various known procedures
9 and combine specific steps, along with a new electrical structure, in the way that is
10 described and claimed by [the patentee.]'); *Gambro Lundia AB v. Baxter Healthcare*
11 *Corp.*, 110 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) ('the
12 record must provide a teaching, suggestion, or reason to substitute computer-controlled
13 valves for the system of hoses in the prior art. The absence of such a suggestion to
14 combine is dispositive in an obviousness determination.', 'Without a suggestion or
15 teaching to combine, [the accused infringer's] case of obviousness suffers a significant
16 deficiency.'); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541, 41 USPQ2d 1829,
17 1833 (Fed. Cir. 1997) (the district court did not err in holding the patent in suit not invalid
18 for obviousness; the patent concerned a cut-resistant yarn for use in making products such
19 as gloves, which, unlike prior art yarns, did not use metallic components such as wire; the
20 yarn includes two core strands wrapped in opposite directions around two covering
21 strands; one core strand is fiberglass; the other core strand and the covering strands are
22 nylon or other material; the patent's claim required, inter alia, that there be a two strand
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EFS filing, Application No. 10/817,347
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core and that the covering strands be ``wrapped about said core at the rate of 8-12 turns per inch.''; a prior art reference showed a yarn with a wrapping rate of 2-24 turns per inch, but the reference disclosed the use of wire, and the accused infringer ``has shown no suggestion or motivation to modify the teaching of the [reference] with regard to non-metallic fibers.''); *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1568, 39 USPQ2d 1321, 1327 (Fed. Cir. 1996) ('[N]one of the prior art references, alone or in combination, teach or suggest a method [specified in the patent's claims]. The prior art simply does not contain many limitations in the claimed method. Furthermore, the record discloses no teaching or suggestion to combine any of these references. The absence of a suggestion to combine is telling in an obviousness determination.''); *B.F. Goodrich Co. v. Aircraft Braking Systems Corp.*, 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996), discussed at N. 12.10(1) infra; *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996); *Beachcombers, International, Inc. v. WildeWood Creative Products, Inc.*, 31 F.3d 1154, 1161, 31 USPQ2d 1653, 1659 (Fed. Cir. 1994) (the patent claims in suit were not obvious in view of the prior art because the art did ``not remotely suggest configuring'' the device as required by the claim); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1993) ('When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.''). *Texas Instruments Inc. V. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993) for the proposition that obviousness is not supported where the references do not demonstrate

EFS filing, Application No. 10/817,347
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1 to combine to produce the invention as presently disclosed.

2 The issue of viewing the present invention as a template is an inappropriate basis
3 for rejection on the basis of obviousness. Your applicant addresses the matter of a
4 “template” in light of the apparent marked structural distinctions between the cited art
5 and the present invention. The prior art “references in combination do not suggest the
6 invention as a whole claimed in the ... patent. Absent such a suggestion to combine the
7 references, respondents can do no more than piece the invention together using the
8 patented invention as a template.” *Heidelberger Druckmaschinen AG v. Hantscho*
9 *Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993) where the
10 court held that “The motivation to combine references can not come from the invention
11 itself.”

12 The applicant respectfully submits that the references, alone and in
13 combination, otherwise must constitute improper use of hindsight reconstruction. *In Re*
14 *Pleuddeman*, 910 F.2d 823, 828, 15 US PQ2d 1738, 1742 (Fed. Cir. 1990); *In Re*
15 *Mahurkar Patent Litigation*, 831 F.Supp. 1354, 28 US PQ2d 1801 (N.D. Ill. 1993). The
16 cases cited stand for the rule that decomposing an invention into its constituent elements,
17 finding each element in the prior art, and then claiming that it is easy to reassemble these
18 elements into the invention, is a forbidden ex post analysis. The applicant submits that it
19 is impermissible to use the claimed invention as an instruction manual or template to
20 piece together the teachings of the prior art so that the claimed invention is rendered
21 obvious. The references simply do not teach to combine the requisite features of your
22 applicant’s invention. “Before the PTO may combine the disclosures of two or more
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24 EFS filing, Application No. 10/817,347
25 on October 29, 2007 by Floyd E. Ivey, 35552.

1 prior art references in order to establish Prima Facie obviousness, there must be some
2 suggestion for doing so, found either in the references themselves or in the knowledge
3 generally available to one of ordinary skill in the art. (*IN RE Jones*, 958 F.2d 347, 351, 21
4 USPQ2d 1941, 1943-44 (Fed. Cir. 1992)). "Evidence of a suggestion, teaching, or
5 motivation to combine prior art references may flow, *inter alia*, from the references
6 themselves, the knowledge of one of ordinary skill in the art, or from the nature of the
7 problem to be solved. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Although a
8 reference need not expressly teach that the disclosure contained therein should be
9 combined with another, *see Motorola, Inc. v. Interdigital Tech. Corp.* , 121 F.3d 1461,
10 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in
11 whatever form, must nevertheless be "clear and particular." *Dembiczak* , 175 F.3d at 999,
12 50 USPQ2d at 1617." *Winner International Royalty Corporation v. Ching-Rong Wang*,
13 202 F.3d 1340(CAFC 2000).

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17 The applicant respectfully requests the Examiner to withdraw the 103 rejections
18 in light of the argument, amendments and responses submitted.
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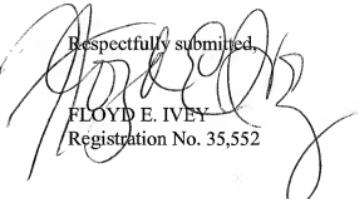
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28 The applicant has set forth arguments and law for the basis upon which prior art
cited under 35 U.S.C. 103 should not result in a conclusion of obviousness for the present
invention as specified and claimed. The applicant has presented features of the present
invention which are not found within the claims of either reference patent. The applicant
has presented law and argument to support the contention that the rejection of claims,
under 35 U.S.C. 103 should be withdrawn and now respectfully requests the Examiner to
withdraw the rejections.

EFS filing, Application No. 10/817,347
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1 **SUMMARY**

2 The applicant has made a good faith effort to respond to the Examiner's Action
3 and respectfully requests the Examiner to withdraw the rejection of Claims 1-10 and to
4 allow the case to proceed to allowance.

5 Respectfully submitted,

6 
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10 *****
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